

REMARKS

Favorable reconsideration and allowance of the subject application are respectfully requested in view of the following remarks.

Summary of the Office Action

Claim 11 stands objected to.

Claims 1, 3 and 13 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Hiramatsu et al.* (U.S. Patent No. 4,974,068).

Claims 5 and 6 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Hiramatsu et al.* in view of *Matsumoto et al.* (U.S. Patent No. 5,514,934).

Claim 7 stands rejected under 35 U.S.C. §103(a) as being unpatentable over *Hiramatsu et al.* in view of *Taguchi et al.* (Japanese Patent No. 07-272672).

Claim 11 stands objected to as being dependent upon a rejected based claim, but would be allowable if rewritten in independent form and to overcome the claim objection.

Claims 8, 9 and 12 stand rejected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form.

Claims 4, 10, 14 and 16-18 are allowed.

Summary of the Response to the Office Action

Applicants amend claim 11 by this amendment. Accordingly, claims 1, 3-14, and 16-18 are currently pending.

The Disposition of the Claims

Applicants appreciate the Examiner's allowance of claim 4, 10, 14 and 16-18 and the Examiner's indication of claims 8, 9, 11 and 12 being allowable. While Applicants agree that these claims are allowable and patentably distinguish over the prior art, Applicants respectfully

do not acquiesce that patentability resides only in the features expressed at paragraph 11 of the Office Action, nor that each and every feature recited in the claims is required for patentability.

In addition, claims 1, 3, 5, 6, 7 and 13 are also believed to be allowable for at least the following reasons.

Objection to Claim 11

Claim 11 stands objected to. Applicants have amended claim 11 to address the Examiner's concerns. Accordingly, Applicants respectfully request the objection to claim 11 be withdrawn.

Claim Rejections Under 35 U.S.C. §103(a)

Claims 1, 3 and 13 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Hiramatsu et al.* This rejection is respectfully traversed for at least the following reasons.

Applicants respectfully submit that *Hiramatsu et al.* fails to render claims 1, 3 and 13 unpatentable, because *Hiramatsu et al.* fails to teach or suggest every feature of claims 1, 3 and 13. For instance, Applicants respectfully submit that *Hiramatsu et al.* fails to teach or suggest the claimed combination as set forth in independent claim 1 including at least "a reading unit that reads the reflected light from the object irradiated with the light from the light source." In addition, Applicants respectfully submit that *Hiramatsu et al.* fails to teach or suggest the claimed combination as set forth in independent claim 13 including at least "reading the reflected light from the object irradiated with the light from the light source while bringing the light source into emission in accordance with the emission mode switched, wherein the invisible light is an infrared light, and the light source emits at least a light including the infrared light in the second mode."

The Office Action acknowledges that *Hiramatsu et al.* differs from Applicants' claimed

combinations in that “the light being read by the image reading unit is light transmitted from the object (film) and not light reflected from the object.” However, the Examiner asserts at paragraph 5 of the Office Action that

“it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the reading device of *Hiramatsu et al.* by reposition the light source (1) to the same side of the original where the image sensor is positioned in order to provide an image reading device for reading a reflective type original.”

However, the arrangement of *Hiramatsu et al.* is directed to “when the image of a negative film is read (emphasis added).” Column 1, lines 14-15 of *Hiramatsu et al.* Applicants respectfully submit that the film document (502) is typically a transparency film. Thus, the Office Action proposes not only repositioning the light source (1) of *Hiramatsu et al.*, but also changing the film document (502) of *Hiramatsu et al.* to be reflective type. M.P.E.P. §2143.01 reminds that “[i]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).” Thus, Applicants respectfully submit that it would not have been obvious to changing the film document of *Hiramatsu et al.* to be reflective type, as proposed by the Office Action, at least because the proposed modifications would render the arrangement of *Hiramatsu et al.* to not be a film scanner. Accordingly, Applicants respectfully submit that *Hiramatsu et al.* fails to teach or suggest the claimed combination as set forth in independent claim 1 including at least “a reading unit that reads the reflected light from the object irradiated with the light from the light source.” In addition, Applicants respectfully submit that *Hiramatsu et al.* fails to teach or suggest the claimed combination as set forth in independent claim 13 including at least “reading the reflected light from the object irradiated with the light from the light source while bringing the light source

into emission in accordance with the emission mode switched, wherein the invisible light is an infrared light, and the light source emits at least a light including the infrared light in the second mode.”

Since *Hiramatsu et al.* fails to teach or suggest every feature of independent claims 1 and 13, it is respectfully submitted that *Hiramatsu et al.* does not render claims 1 and 13 unpatentable. Further, since claim 3 depends from claim 1, it is respectfully submitted that *Hiramatsu et al.* also does not render claim 3 unpatentable. Accordingly, withdrawal of the rejection of claims 1, 3 and 13 under 35 U.S.C. §103(a) is respectfully requested.

Claims 5 and 6 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Hiramatsu et al.* in view of *Matsumoto et al.* This rejection is respectfully traversed for at least the following reasons.

Applicants respectfully submit that *Hiramatsu et al.* in view of *Matsumoto et al.* fail to render claims 5 and 6 unpatentable, because *Hiramatsu et al.* and *Matsumoto et al.*, whether taken separately or in combination, fail to teach or suggest every feature of claims 5 and 6. For instance, Applicants respectfully submit that neither *Hiramatsu et al.* nor *Matsumoto et al.* teaches or suggests the claimed combination as set forth in independent claim 5 including at least “a reading unit that reads the reflected light from the object irradiated with the light from the light source.”

Applicants respectfully submit that *Hiramatsu et al.* fails to teach or suggest the reading unit that reads the reflected light, as set forth in claim 5, for the above-discussed reasons. Further, it is respectfully submitted that *Matsumoto et al.* is not relied upon to teach a reading unit that reads a reflected light, and does not remedy the deficiencies of *Hiramatsu et al.* Accordingly, Applicants respectfully submit that neither *Hiramatsu et al.* nor *Matsumoto et al.*

teaches or suggests the claimed combination as set forth in independent claim 5 including at least “a reading unit that reads the reflected light from the object irradiated with the light from the light source.”

Since *Hiramatsu et al.* and *Matsumoto et al.*, whether taken separately or in combination, fail to teach or suggest every feature of independent claim 5, it is respectfully submitted that *Hiramatsu et al.* in view of *Matsumoto et al.* do not render claim 5 unpatentable. Further, since claim 6 depends from claim 5, it is respectfully submitted that *Hiramatsu et al.* in view of *Matsumoto et al.* also do not render claim 6 unpatentable. Accordingly, withdrawal of the rejection of claims 5 and 6 under 35 U.S.C. §103(a) is respectfully requested.

Claim 7 stands rejected under 35 U.S.C. §103(a) as being unpatentable over *Hiramatsu et al.* in view of *Taguchi et al.* This rejection is respectfully traversed for at least the following reasons.

Applicants respectfully submit that *Hiramatsu et al.* in view of *Taguchi et al.* fail to render claim 7 unpatentable, because *Hiramatsu et al.* and *Taguchi et al.*, whether taken separately or in combination, fail to teach or suggest every feature of claim 7. For instance, Applicants respectfully submit that neither *Hiramatsu et al.* nor *Taguchi et al.* teaches or suggests the claimed combination as set forth in independent claim 7 including at least “a reading unit that reads the reflected light from the object irradiated with the light from the light source.”

Applicants respectfully submit that *Hiramatsu et al.* fails to teach or suggest the reading unit that reads the reflected light, as set forth in claim 7, for the above-discussed reasons. Further, it is respectfully submitted that *Taguchi et al.* is not relied upon to teach a reading unit that reads a reflected light, and does not remedy the deficiencies of *Hiramatsu et al.*

Accordingly, Applicants respectfully submit that neither *Hiramatsu et al.* nor *Taguchi et al.* teaches or suggests the claimed combination as set forth in independent claim 7 including at least "a reading unit that reads the reflected light from the object irradiated with the light from the light source."

Since *Hiramatsu et al.* and *Taguchi et al.*, whether taken separately or in combination, fail to teach or suggest every feature of independent claim 7, it is respectfully submitted that *Hiramatsu et al.* in view of *Taguchi et al.* do not render claim 7 unpatentable. Accordingly, withdrawal of the rejection of claim 7 under 35 U.S.C. §103(a) is respectfully requested.

Conclusion

In view of the foregoing, withdrawal of the rejections and allowance of the pending claims are earnestly solicited. Should there remain any questions or comments regarding this response or the application in general, the Examiner is urged to contact the undersigned at the number listed below.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,
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